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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,859	08/23/2001	Masahiko Enari	09812.0651	9497
22852	7590	07/06/2009		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER REFAI, RAMSEY	
			ART UNIT	PAPER NUMBER
			3627	
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			07/06/2009 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/935,859

Applicant(s)

ENARI, MASAHIKO

Examiner

Ramsey Refai

Art Unit

3627

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6,8-10 and 12-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6,8-10 and 12-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Responsive to Amendment filed April 3, 2009. Claims 6, 10, 15 and 16 were amended. Claims 6, 8-10, 12-22 remain are pending.

Response to Arguments

1. Applicant's arguments have been fully considered but they are not persuasive.

- In the remarks, the Applicant argues with substance:

Argument: *The Applicant traverses the Examiner's Official Notice*

In response, the Examiner asserts that the Applicant has not adequately traversed the Official Notice taken in the previous action. " **To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate.**" MPEP 2144.03c. "An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the official notice". In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA 1971). **The common knowledge or well-known in the art statement is taken to be admitted prior art because the traverse was inadequate.**

MPEP 2144.03c

2. Applicant's other arguments have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6, 8-10, 12-16, 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rautila (US Patent No. 6,714,797) in view of Jones (US 6,697,944) in further view of Burke et al (US 6,604,681) and yet in further view of Kupka et al (US 6,434,535).

5. As per claim 6, Rautila teach a method for providing electronic content to a customer using a remote user terminal and a store information terminal, the method comprising the steps of:

accessing a menu including a plurality of electronic content items available for purchase using the remote user terminal (**column 6, lines 2-7**);

selecting an electronic content item using the remote user terminal (**column 6, lines 5-7**);

obtaining the identification code, via a first communication channel (**column 6, line 1; internet 150**), for identifying the selected electronic content item (**column 6, line 35-40, column 8, lines 31-37**); wherein the identification code corresponds to the selected_electronic content item (**column 9, lines 60-63, column 6, lines 1-8 and 35-38**) ;

inputting the identification code at the store information terminal (**column 6, lines 50-53**);

enabling the customer to purchase (**column 6, lines 53-64**), via a second communication channel, the second communication channel being different from the first communication channel (**hotspot network 50**), the retrieved electronic content item corresponding to the identification code (**column 6, lines 50-64**),; and

enabling the customer to download the electronic content item from the store information terminal (**column 6, line 53-column 7, line 5**); and

Rautila fail to explicitly teach enabling the customer to download the electronic content item from the store information terminal *to a portable recording medium loaded into the store information terminal*. However, in the same field of endeavor, Jones et al teach a kiosk with a USB interface that allows a user to download content onto the USB (**see at least column 11, lines 45-50, fig 4**).

Furthermore, Rautila fail to teach *enabling the customer to view on a screen of the store information terminal physical commodities that are available for purchase*. However, in the same field of endeavor, Burke et al teach a touch screen kiosk in a store that allow customers to view and purchase goods in the store (**see at least column 3, lines 3-9**). It would have been obvious to one of ordinary skill in the art to combine the teachings of Rautila, Jones et al, and Burke et al because doing so would allow a customer in Rautila to download the content on to a portable medium from a kiosk at the store and to view goods available in the store for purchase.

Additionally, Rautila teach using an identifier to download the content (**see at least column 9, lines 60-63, column 6, lines 1-8 and 35-38**) fails to explicitly teach a plurality of electronic content items, *each having an identification code*, wherein the identification code corresponds *only to the selected electronic content item*. However, in the same of endeavor, Kupka et al teach a system and method for distribution of electronic content wherein the media includes a unique identifier that is used to identify the content for download (**see column 7, lines 53-65**). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to include this feature in Rautila, as modified above, because doing so would allow for each content item to be individually identified for download.

It is noted that **KSR** forecloses the argument that a **specific** teaching, suggestion, or motivation is required to support a finding of obviousness. Under **KSR**, a claim would have been obvious if the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than **predictable results** to one of ordinary skill in the art at the time of the invention.

6. As per claim 8, Rautila teaches wherein the menu including the plurality of electronic content items available for purchase is located on a server accessible by the remote user terminal via a network (**column 6, lines 2-8**).
7. As per claim 9, Rautila teaches wherein the step of obtaining the identification code comprises downloading the identification code to a portable recording medium (**column 6, lines 35-38; unique order number downloaded to mobile station 10**).
8. As per claims 10, 12-13, these claims contain similar limitations as claims 6, 8-9 above, therefore are rejected under the same rationale.
9. As per claims 14, 21, in Rautila-Jones et al-Burke, Burke teach when the consumer first touches the kiosk display screen, the screen shows a plurality of product categories and subcategories but fails to explicitly teach wherein the screen displays an opening screen comprising *at least one of a car menu, a book menu, a shipping menu, a photo print menu, a massage service menu, a music download menu, a travel menu, and a ticket menu*. However, it would have been obvious to one of ordinary skill in the art to modify Rautila-Jones et al-Burke to

include a book menu category because doing so would allow a user to view books available for purchase at the store.

10. As per claim 15, Rautila teach **wherein the screen displays an opening screen comprising a car menu**, wherein car menu is used to open a car-related menus for at least one of retrieval and sale of a car, retrieval and sale of car goods, and renting of a car (**limitation met since only one menu (book menu) is required by claim 14**).

11. As per claim 16, Rautila teach **wherein the screen displays an opening screen comprising a photo print menu**, wherein a selection of the photo print menu by the customer provides a service for printing recordings made by an electronic still camera. (**limitation met since only one menu (book menu) is required by claim 14**).

12. As per claims 20, 22, Rautila-Jones et al-Burke teaches providing an ability to use the store terminal to purchase one of the physical commodities that is not displayed in a store (**Burke: see at least column 3, lines 3-9**) .

13. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rautila (US Patent No. 6,714,797) in view of Jones (US 6,697,944) in further view of Burke et al (US 6,604,681) and yet in further view of Kupka et al (US 6,434,535) and in further view of Kaplan (US 5,963,916).

14. As per claim 17, Rautila fail to teach *wherein the screen displays a list of recommended pieces of music and a promotion video*. However, in the same field of endeavor, Kaplan teach

that a list of recommended music and a promotional video are displayed on a kiosk screen (**see at least figs 5A-5F, 39, column 2, lines 35-41**). It would have been obvious to one of ordinary skill in the art to combine Kaplan as modified above because doing so would allow a user to view recommended content and view a video regarding products available for purchase.

15. As per claim 18, Rautila fail to teach *wherein a list of goods related to an artist is displayed on the screen when an artist goods menu is selected by the customer*. However, in the same field of endeavor, Kaplan teaches a list of available albums relating to an artist is displayed on a kiosk screen (**see at least figs 6A-6C**). It would have been obvious to one of ordinary skill in the art to combine Kaplan as modified above because doing so would allow a user to browse music related to a specific artist.

16. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rautila (US Patent No. 6,714,797) in view of Jones (US 6,697,944) in further view of Burke et al (US 6,604,681) and yet in further view of Kupka et al (US 6,434,535) and in further view of "Official Notice".

17. As per claim 19, Rautila fails to teach *wherein a list of scheduled concerts related to an artist is displayed on the screen when a ticket menu is selected by the customer*. However, "Official Notice" is taken that the concept and advantage of this feature is well known in the art. It would have been obvious to one of ordinary skill in the art to modify Rautila-Jones et al-Burke to include this feature because doing so would allow a customer to also order tickets for a scheduled concert using the kiosk at the store. **The common knowledge or well-known in the**

art statement is taken to be admitted prior art because the traverse was inadequate.

MPEP 2144.03c

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ramsey Refai
June 24, 2009
/Ramsey Refai/
Examiner, Art Unit 3627